



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,865	09/05/2003	Alberto Silvestri	1006-002us	8102

7590 11/27/2006

SOFER & HAROUN, LLP
Suite 910
317 Madison Avenue
New York, NY 10017

EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

41

Office Action Summary	Application No. 10/656,865	Applicant(s) SILVESTRI, ALBERTO	
	Examiner Pradeep C. Battula	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 14-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, and 14 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmerich (U.S. 6,142,530) in view of Long (U.S. 6,572,149) and Butterworth (2,321,184).

In regards to Claim 11, Emmerich discloses an advertisement display having at least one page 3 with a first image thereon 5, the image having a plurality of visual elements (Column 2, Lines 32 – 37), said advertisement display comprising: a first panel 7, said first panel being attached to said at least one page and having a second image (Column 2, Lines 41 – 45; Figure 1, Items 5, 7); said second image having a first variation to at least one visual element relative to a corresponding visual element on said first image such that when said first panel is placed on said page over said first image, said second image on said first panel aligns with said first image; a first edge located on said first panel (Column 2, Lines 41- 45 and Lines 57 – 59).

With respect to an advertisement display for placement within a printed publication; it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Emmerich does not disclose said second image being substantially identical to a portion of said first image; and a second panel attached along said first edge of said first panel, such that said second panel is configured to be folded onto said first panel along said edge, said second panel having a third image thereon, said third image also being substantially identical to a portion of said first image, said third image on said second panel including a second variation relative to said corresponding visual element of said first image and said first and second variations to said corresponding visual element being different from one another.

Long discloses a second panel 11 (right of Line B and any horizontal line [G – K]) attached along said first edge of said first panel (Column 2, Lines 65 – 67; Column 3, Lines 1 – 2; Figure 1, Item 11), such that said second panel is configured to be folded onto said first panel along said edge (Column 3, Lines 1 – 8), said second panel having a third image thereon (Column 3, Lines 17 – 25); said third image on said second panel including a second variation relative to said corresponding visual element of said first image (Column 3, Lines 17 – 25). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use one of Long's folded panel strips (Line A and across separated by Lines G – K) and use them in place of Emmerich's first panel 7 in order to create multiple photographic representations in conjunction with photograph 5 and explanatory text 4 (text disclosed Column 3, Lines 35 – 37 and 44 – 52). Furthermore, the modification discloses that when said second panel is placed on said page over said first image, said third image on said first panel aligns with said first image (Column 2, Lines 57 – 59; Emmerich).

Emmerich modified by Long does not disclose said second and third images being substantially identical to a portion of said first image.

Butterworth teaches an associated sheet 22 (Page 2, Column 1, Lines 46 – 49), the associated sheet having an overlaid portion 25 (Page 2, Column 2, Lines 11 – 15) and a sheet 15 having a first identification of one or more articles 26 (Page 2, Column 2, Lines 19 – 23). Butterworth also discloses the overlaid portion of the associated sheet is also printed with the first identification (Page 2, Column 2, Lines 11 – 15). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to print desired indicia on a surface that is to be covered and have the covering sheet have all or a portion of substantially identical indicia in order to prevent Emmerich's photograph 5 from having its usefulness and value be affected when Long's panel is removed (Page 2, Column 2, Lines 15 – 19; Butterworth).

In regards to Claim 14, as applied to Claim 11, Emmerich modified by Long and Butterworth further discloses a third panel coupled to at least one edge of said second panel (Figure 1; right of Line C, any single row below any line [G – K]; Long), wherein said third panel is configured to be folded onto said second panel before said second panel is folded onto said first panel (Column 3, Lines 1 – 8; Figure 1, Item 11).

In regards to Claim 15, as applied to Claim 11, Emmerich modified by Long and Butterworth further discloses a fourth panel coupled to a second edge of said first panel (Figure 1; left of Line B, any single row below any line [G – K]; Long), wherein said fourth panel is configured to be folded onto said first panel before said second panel is folded onto said first panel (Column 3, Lines 1 – 8, Item 11; Long).

In regards to Claim 16, as applied to Claim 11, Emmerich modified by Long and Butterworth further discloses the coupling between said panels is formed along a solidly formed edge (Figure 1; Column 3, Lines 5 – 8; discloses that fold lines A – F may be perforations, but does not disclose perforations are required; Long).

In regards to Claim 17, as applied to Claim 11, Emmerich modified by Long and Butterworth further discloses the coupling between said panels is formed along a perforated edge (Column 3, Lines 5 – 8; Long).

In regards to Claim 18, as applied to Claim 11, Emmerich modified by Long and Butterworth further discloses said panels may be removed independently from one another (Column 3, Lines 5 – 8; Long).

In regards to Claim 19, as applied to Claim 18, Emmerich modified by Long and Butterworth further discloses said advertisement display is any one of coupons, business cards, product samples, a mailer for return mailing, and a list of store locations (Column 3, Lines 5 – 25; Figure 4; Long).

Response to Amendment

Applicant's response to Claims 11 and 14 – 19 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3722

Conclusion

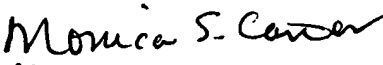
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
November 13, 2006


MONICA CARTER
SUPERVISORY PATENT EXAMINER